



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS

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May 12, 2004  
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In re Application of	:	Sheila D. Fox-Lovell
Serial No.	:	09/817,826
Examiner	:	Monica S. Carter
Group Art Unit/	:	3722
Filed	:	March 26, 2001
For	:	Customer Registration System and Corresponding Method of Use

SUPPLEMENTAL APPEAL BRIEF  
UNDER 37 C.F.R. § 1.193

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This Supplemental Appeal Brief Under 37 C.F.R. §1.193 supplements and supercedes the Appeal Brief Under 37 C.F.R. §1.192 Filed November 14, 2003

**I. REAL PARTY IN INTEREST**

The real party in interest is Shandy Graphics, Inc., assignee of the entire right, title, and interest in and to the above-referenced application for patent.

**II. RELATED APPEALS AND INTERFERENCES**

1. There are none.

### III. STATUS OF CLAIMS

Claim 1 has been cancelled in favor of claim 15.

Non-elected claims 12, 13 and 14 have been withdrawn from consideration.

Independent claim 15 and dependent claims 2 through 11, inclusive, are pending. All stand finally rejected under 35 U.S.C. §103(a) as unpatentable over *Jackson '090* in view of *Blank '482* pursuant to the Final Office Action mailed June 20, 2003. In addition, all pending claims stand not finally, but twice or more rejected over *Baldwin '904* in view of *Jackson '090* pursuant to the Office Action mailed February 13, 2004.

In response to Appellant's Appeal Brief filed November 14, 2003, the Examiner re-opened prosecution by Office Action mailed February 13, 2004. That Office Action included citation of ten (10) new references including *Baldwin '904*. Claims 15 and 2 through 11, inclusive, were rejected under 35 U.S.C. §103(a) as unpatentable over *Baldwin '904* in view of *Jackson '090*.

Although the Office Action of February 13, 2004 did not withdraw the final §103(a) rejection over the alleged combination of *Jackson '090* and *Blank '482*, it failed to substantively address any aspect of the arguments made in Appellant's Appeal Brief of November 14, 2003. Without further explanation, the Examiner stated:

*"Applicant's arguments with respect to claims 2-11 and 15 have been considered but are moot in view of the new ground(s) of rejection."*

2/13/04 Office Action at p. 7

Clearly, those arguments are not moot in view of the Examiner's failure to withdraw the rejection on which they were based. For the convenience of the Board, those arguments have been incorporated in this Supplemental Appeal Brief so that all arguments relating to all outstanding rejections can be considered without necessity of referring back to the original Appeal Brief filed November 14, 2003.

#### **IV. STATUS OF AMENDMENTS**

An Amendment Under 37 C.F.R. §1.116 was filed June 20, 2003 to overcome any objection to claim 4. Per Advisory Action mailed October 1, 2003, that amendment has been entered for purposes of appeal.

#### **V. SUMMARY OF THE INVENTION**

Various types of businesses, especially services businesses, routinely register customers as they arrive at a place of business. Prior art customer registration systems are usually in the form of a simple, pre-printed "customer sign-in sheet" placed on a clipboard at a reception or registration desk adjacent a customer waiting room. Prior art sign-in sheets are typically forms pre-printed with multiple rows and columns. The columns have pre-printed headings which identify the type of information to be filled in by each customer. The first column commonly calls for the customer's name. It is also common to include a column with a heading calling for the customer to fill in the date and/or time of day they register. Other columns may have headings calling for other information. For example, in the case of a business such as a health care service provider, prior art patient sign-in sheets sometimes include a column heading for the patient to fill in the name of their physician or even the reason for their visit.

With prior art customer registration systems, when each patient, or other customer, arrives at the registration desk, they fill in the registration form with their name, arrival time and any other information called for by its column headings. Each customer typically enters their information on the first available uncompleted row of the form. As they do so, the names and other potentially confidential information filled in by earlier customers in the rows above are readily visible to that customer. The confidentiality of the information entered by customers is compromised and the customer's privacy is opened to invasion.

#### **Claim 15**

The invention of claim 15 is a customer registration system that improves the protection of the confidentiality of information entered by the customer. It includes a first substrate (100) to which is detachably adhered a plurality of registration labels (101-120). Each label (101-120)

has first indicia (122) identifying the position of that label in an uninterrupted sequence. (see e.g. Fig. 1) Each label (101–120) also includes at least one field (124) within which the customer may enter their name and/or other information. The first substrate (100) is located in a first location such as a front desk of the establishment which is sufficiently accessible to customers to permit each customer to view the labels which are adhered to the first substrate and enter information in the field while the label remains adhered to the substrate. (see specification at p. 11 lines 14–26) Thus, after the information is entered on one of the labels, (101–120) the label, being "detachable", may be removed from the first substrate (100) so it will no longer be viewable by subsequent customers who arrive to enter their own information on one of the labels (101–120) which remain detachably adhered to the first substrate (100).

To retain and archive the completed labels (101–120) removed from the first substrate (100), the invention of claim 15 further includes a registration log having at least one second substrate (300). The second substrate (300) has a series of label-retaining spaces (301–320), each of which is identified by one of a series of second indicia (324). The second indicia (324) on the second substrate (300) correspond with the first indicia (122) so as to associate each one of the label retaining spaces (301–320) with a respective corresponding one of the labels (101–120). As shown in Figs. 3A and 3B, each of the spaces (301–320) includes an area to which a corresponding one of the labels (101–120) can be attached to second substrate (300) after a label (101–120) has been detached from the first substrate (100) following a customer's entry of information on that label (101–120). While the first substrate (100) is locatable at the front desk or other customer accessible first location, the second substrate (300) is locatable at a second location at which the entered information is out of customer view, thereby protecting the confidentiality of the entered information. In addition to protecting confidentiality of the information filled in by the customer on the labels, the invention of claim 15 provides other advantages.

The correspondence between the first indicia (122) identifying the position of each registration label (101–120) in an uninterrupted sequence and the corresponding sequence of second indicia (324) identifying each corresponding one of the label retaining spaces (301–320) ensures that after completion, each label (101–120) can be placed in a specifically designated location on the second substrate (300). In the language of claim 15 itself, such correspondence serves "to associate each one of said spaces with a respective corresponding one of said labels

according to said sequence". As a result, a simple and quick visual inspection of the first substrate (100) and second substrate (300), can rapidly confirm that no labels (101-120) filled out by customers have been lost or stolen.

In addition, the recited sequential correspondence between the first (101-120) indicia on the registration labels (122) and the second indicia (324) on the corresponding label retaining spaces (301-320) deters fraud and theft. For example, in the absence of the recited correspondence, a dishonest receptionist at a physician's office could detach one of the labels (101-120) from the first substrate (100) after it had been filled out by a patient and deliberately not affix a completed label to the second substrate (300) of the registration log in order to conceal theft of a cash co-payment received from that patient. Since there would be no record of that patient in the registration log, the theft might not otherwise be detectable. However, in addition to confidentiality protection, the invention as claimed provides a deterrent to such dishonest behavior since it would readily be apparent from the sequential first and second indicia that a label (101-120) removed from the first substrate (100) had not been logged in by placement onto the second substrate (300).

### **Claim 2**

This claim depends from claim 15. It is further limited to a system in which the registration log includes more than one second substrate (300) each of which bears third indicia (328), a page number for example, identifying the sequential order of substrates in the registration log.

### **Claim 3**

This claim depends from claim 15 and is further limited to a system in which the second substrate (300) further includes a designated area (326) for entry of a date services were provided. (See e.g. Fig. 3A) This permits the service provider to organize the registration log by date so that all customers registered on the entered date can readily be identified irrespective of whether or not those customers entered such date on their respective registration labels.

#### **Claim 4**

This claim depends from claim 15 and is further limited to a registration system including text (322) associated with each of the label retaining spaces including instructions to attach the labels therein. Inclusion of such text (322) makes the system easy to use and minimizes the training required to enable employees to use the system properly. (See e.g. Fig. 3A)

#### **Claim 5**

This claim depends from claim 15 and is further limited to a system which includes a plurality of first substrates (100) as well as a plurality of second substrates (300).

#### **Claim 6**

This claim depends from claim 15 and is further limited to a customer registration system wherein the labels (101-120) are arranged in sets, at least two of which sets have the same sequence of the first indicia (124).

#### **Claim 7**

This claim depends from claim 15 and is further limited to a customer registration system in which the first substrate (100) includes mutually opposed first and second surfaces, only one of which bears labels (101-120).

#### **Claim 8**

This claim depends from claim 15 and is further limited to a customer registration system in which the first substrate (100) includes two mutually opposed surfaces both of which bears registration labels (101-120).

### **Claim 9**

This claim depends from claim 15 and is further limited to a customer registration system in which the first indicia (124) are comprised of at least one alphabet letter and/or number.

### **Claim 10**

This claim depends from claim 15 and is further limited to a customer registration system in which the second indicia (324) are comprised of at least one alphabet letter and/or number.

### **Claim 11**

This claim depends from claim 15 and is further limited to a customer registration system in which the registration log comprises a spiral bound book as disclosed in the specification at page 12 lines 22-24.

## **VI. ISSUES**

1. Whether the Examiner erred in rejecting claims 15 and 2-11 under 35 U.S.C. §103(a) as being unpatentable over *Jackson '090* in view of *Blank '482*.
2. Whether the Examiner erred in rejecting claims 15 and 2-11 under 35 U.S.C. §103(a) as being unpatentable over *Baldwin '904* in view of *Jackson '090*.

## **VII. GROUPING CLAIMS**

Applicant submits the Examiner's rejections of each of dependent claims 2 through 11 are improper for at least the same reasons as pointed out below as to claim 15. Accordingly, if the Board reverses the rejection of claim 15, the rejections of claims 2 through 11 inclusive must also be reversed. No admission is made that any of claims 2 through 11 inclusive are not separately patentable and no determination of whether or not any of those claims are separately patentable is necessary in order for the Board to reverse the rejections of claims 15 or 2 through 11, inclusive.

## VIII. ARGUMENTS

### A. Summary of the Arguments

The rejections under 35 U.S.C. §103(a) are improper because the Examiner has misconstrued claim 15 by improperly refusing to give weight to meaningful claim elements in the nature of printed matter which bears a functional relationship to its substrate. Moreover, the combinations of prior art postulated by the Examiner consist entirely of non-analogous art whose combination lacks any reasonable motivation and do not include, teach or expressly or impliedly suggest the invention of claim 15 as a whole when properly construed. The rejections of the dependent claims are improper for at least those same reasons.

### B. The Prior Art Relied on By the Examiner

#### *Jackson '090*

*Jackson '090* deals not at all with issues of registering customers at a place of service or with protecting confidential information they enter while registering. It relates to a photograph log for enabling photographers to enter information about photographs they take on a given roll of film and to later transfer that information to the reverse side of the photos after they have been developed. The log (10) comprises a spiral book. Each of its pages includes a series of detachable labels (14A). Each of the labels (14A) is pre-printed with a frame number (14AA) which identifies a frame in a roll of film. Also pre-printed on each label (14A) is a place (14AC) to fill in the date and a frame description area (14AB) to describe the photo taken on the individual frame of film to which a given label (14A) corresponds.

In use, the labels (14A) are filled in by the photographer as the roll of film is exposed. The only use of the labels (14A) after they have been filled in which is described or suggested by the reference is to "affix the label to the photo when the negatives are developed" (col. 3, lines 61 & 62). There is no teaching or suggestion to affix more than one label (14A) to the same photograph or to affix the labels to a log or any other substrate other than an individual developed photograph after removal of that label (14A) from the spiral book.



### **Blank '482**

*Blank '482* is entitled "Card with Removable Reusable Element". A transaction card, promotional card or membership card (10) is provided with a removable and reusable label (18). According to the patent, either the card (10) or label (18) may be printed to include bar codes, alpha numeric numbers, letters, symbols, check digits or other indicia (19). (See col. 5, lines 45-49). However, there is no teaching or suggestion of providing labels (18) with a field in which information of any kind may be entered by a customer. As shown in Fig. 2 of the patent and relied on by the Examiner, *Blank '482* also discloses a registration form (26) suitable for use with the transaction card (10) and label (18) combination shown in Figs. 1a and 1b. As taught at col. 6, lines 12-22, the form (26) includes a field for entering information by the holder of the transaction card and a separate field (28) for receiving the label (18) from the card (10). However, there is no suggestion of providing a field for receiving a label where the label is one on which a customer, or anyone else other than the manufacturer of the printed label, enters information on that label. The only information on the label (18) of *Blank '482* is whatever is printed there by its manufacturer. There is also no teaching or suggestion of providing form (26), or any other substrate, with a *plurality* of such label retaining spaces. Perhaps most significantly, *Blank '482* does not disclose or suggest providing form (26) with any sequential indicia of its own, either corresponding sequentially with the indicia (19) on label (18), or otherwise.

### **Baldwin '904**

*Baldwin '904* is entitled "Notebook with Selectively Changeable, Removeable and Replaceable Information Carriers". As explained at col. 1 lines 8-28, the patent is directed to solving the problem of personal books such as address and telephone books in which information recorded becomes out of date or otherwise requires amending. An example described at col. 1 lines 49-52 is that an entry for "Jane Doe" would originally belong under the "D" section of the book, but would belong in the "S" section after she married "John Smith".

To permit making changes to entered information, the patent discloses a ring binder (10) having pages (30) of waxed paper or glossy plastic to which blanks or pre-printed adhesive labels, (25) on which information is entered by a user, can be releasibly secured. Thus, when a label (25)

becomes obsolete, it can be removed entirely or it can be replaced with a corrected or updated label (25) and relocated to another page (30) within the binder (10).

To facilitate transferring labels (25) between one binder page and another, the patent discloses a hinged label "parking" board (20) which is mounted within a pocket (18) formed in the rear cover (13) of the ring binder (10). A label (25) to be moved from one of the pages (25) within the ring binder (10) to another page (25) within the ring binder (10) can be temporarily mounted on parking board (20) after being detached from its original page (25) before being attached to its new destination page (25).

Completely absent from *Jackson '090*, *Blank '482* and *Baldwin '904*, individually and/or collectively is any teaching of any structure or method for protecting the confidentiality of any information entered by a person.

### C. Discussion

The Examiner's reliance on *Jackson '090* and *Blank '482* is also improper because neither of those references is germane to the problem which confronted the inventor of the claimed invention: protecting the confidentiality of information entered by a customer during registration at a place of business. No plausible explanation has been provided or is apparent as to why a person of ordinary skill in the art confronted with that problem would have looked to a photographer's log book or to a transaction, promotional or membership card for a solution. The postulated combination is fatally flawed for other reasons as well.

#### (i) **The Rejection over *Jackson '090* in view of *Blank '482* is Improper.**

Using impermissible hindsight, the Examiner has constructed a rejection based on an implausible combination of references which, by her own admission, does not result in a combination that includes all of the elements recited in claim 15. The Examiner acknowledges:

*"Jackson as modified by Blank discloses the claimed invention except for the label retaining spaces having a series of second indicia corresponding to the first indicia..." (emphasis added).*

6/20/03 Office Action at p. 3.

Citing neither prior art nor articulating any alleged reason why such elements would supposedly have been obvious to a person of ordinary skill in the art, the Examiner brushes aside the corresponding claim recitations as follows:

*"It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any additional desired indicia in the label retaining spaces since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. In re Gulack, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of registration log does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability."*

6/20/03 Office Action at pp. 3&4

That is simply incorrect. The role played by the recited series of first indicia (122) on the labels (101-120), the recited series of second indicia on the second substrate (300) and the recited sequential correspondence between those two series of indicia is unquestionably functional in nature and goes well beyond the substrates providing support for the indicia. To the contrary, it is a functional relationship that goes to the core of the utility of the claimed invention.

Moreover, the requisite functional relationship between the indicia and their respective substrates is not left to inference. It is a functional relationship that is expressly recited in the claim 15, namely:

*"to associate each one of said spaces with the respective corresponding one of said labels according to said sequence."*

The recited association function is neither expressly or impliedly disclosed by any of the prior art of record since by the express admission of the Examiner quoted above, the postulated combination of prior art lacks label retaining spaces having a series of second indicia

corresponding to the first indicia. The Examiner provides no reasoned argument as to why a person of ordinary skill in the art might have been motivated to further modify the postulated combination to supply the missing claim elements. Improperly dismissing the relationship between the first and second indicia and their respective substrate as one of "mere support", the Examiner offers only the unsupported, conclusory statement that:

*"The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of registration log does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for the patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability."*

6/20/03 Office Action at p.4.

The recited sequentially corresponding first and second indicia are neither mere decoration or ornamentation nor a display of trivial or arbitrary information. They function, as expressly recited in claim 15 to "associate each one of the said spaces with a respective corresponding one of said labels according to said sequence". That function relates indicia to substrate by identifying which particular one of the label retaining spaces (301-320) on the second substrate (300) receives a given one of the labels (101-120) removed from the first substrate (100) after being filled in by a customer. That function is also one which goes to a key purpose of the invention: protecting the confidentiality of the information a customer fills in when registering at a physicians office or other place of business.

The correspondence between the first indicia (122) identifying the position of each registration label (101-120) in a sequential arrangement and the corresponding second indicia (324) identifying the corresponding label-retaining spaces (301-320) associates each label (101-120) with a particular label-retaining space (301-320), thereby providing a security function which is expressly noted in the original Specification at page 11, lines 8-11. Namely, the correspondence between those indicia ensures that each registration label (101-120) is placed in the appropriate space (310-320) of the registration log. This helps protect the confidentiality of the information customers enter on the labels (101-120) by facilitating confirmation that every

label (101-120) that has been filled out by a customer is present in the registration log and has not been lost or stolen. The uninterrupted sequential association afforded by the indicia also offers at least one other significant functional advantage: it deters fraud and theft.

For example, as noted above, in the absence of the recited correspondence of indicia, a dishonest receptionist at a physician's office might detach a completed label from the first substrate after it had been filled out by a patient and deliberately fail to place the completed label in the registration log in order to steal cash co-payment received from the patient without detection. Since there would be no record of the patient in the registration log, the theft might not be detectable. The invention as claimed serves to deter such dishonest behavior. The recited correspondence between the first indicia (122) on the first substrate (100) which initially carries the labels (101-120) and the second indicia (324) on the second substrate, to which the labels (101-120) are subsequently attached after being filled out by a customer, it can readily be determined whether a label had been removed from the first substrate (100) but not placed on the second substrate (300) of the registration log. In addition, the recited uninterrupted sequential arrangement of registration labels (101-120) provided by the first indicia (124) makes it possible to determine the approximate window of time in which a label went missing. Such information would be of great value in an audit or investigation of the reason for a missing registration label (101).

In view of the foregoing, it can readily be appreciated that Claim 15 defines a functional relationship between substrate and printed matter that is not merely one of physical support as the Examiner asserts. Accordingly, the Examiner has misconstrued claim 15 by intentionally failing to give weight any weight to the recitations of "a series of first indicia identifying the position of each of said labels in an uninterrupted sequence," and "a series of second indicia corresponding to said first indicia".

The case the Examiner cites in support of her rejections, *In re Gulack*, 217 U.S.P.Q. 401 (Fed. Cir. 1983), actually weighs strongly against them. In that case, the U.S. Court of Appeals for the Federal Circuit *reversed* the Board's affirmance of a rejection of claims under 35 U.S.C. §103. The invention there comprised: (1) a band, ring or set of concentric rings (2) a plurality of individual digits imprinted on the band or ring at equally spaced intervals, and (3) an algorithm by which the digits are developed. The band was described as preferably being an endless loop of

paper fabric or plastic material. By manipulating the claimed device in the manner described in the specification, one could perform magic tricks or display certain aspects of number theory. According to the Federal Circuit, the "band served two functions: it supports the appropriate sequence of digits and it presents the digits as an endless sequence with no discrete beginning or end" *Gulack*, id at p. 402.

The Board had affirmed the Examiner's rejection of the claims on the basis there was no functional relationship between the printed matter and the substrate and declined to accord patentable weight to the printed matter. In reversing the Board, the Federal Circuit unequivocally, stated that:

*"[d]ifferences between an invention and prior art cited against it cannot be ignored merely because those differences reside in printed matter"*

*In re Gulack*, 217, U.S. P.Q. at 403

In a footnote to the above statement, the Court cautioned that:

*"printed matter rejection" under §103 stands on questionable legal and logical footing. Standing alone, the description of an element of the invention as printed matter tells nothing about the differences between the invention and the prior art or about whether the invention was suggested by the prior art." at Gulack, 217 U.S. P.A. 399, 403 F.N. 8.*

In the same footnote, the Court cited a string of cases supporting the proposition that "the CCPA has considered *all* of the limitations, in deciding whether the invention would have been obvious". (emphasis in original). Continuing, the Court stated that in "*In re Royka*, 490 F.2d at 985, 180 U.S.P.Q. at 583, the CCPA, notably weary of reiterating this point, clearly stated that printed matter may well constitute structural limitations on which patentability can be based". *In re Gulack*, 217 U.S.P.Q. 399, 403 at F.N.8. The Court went on to instruct:

*"Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter." Under Section 103, the board cannot dissect a claim, excise the printed matter from it and declare the remaining portion of the mutilated claim to be unpatentable as a whole.*

*In re Gulack* 217 U.S. P.Q. 399 at 403 (Fed. Cir.1983.)

Although the Examiner here cites *In re Gulack*, Id, in support of her rejections, she has not only ignored its express instruction, she has done exactly what the Court has said was improper. She has read the printed matter out of claim 15 and its dependents and rejected the mutilated remainders of those claims.

The functional relationship between the first and second series of indicia and their respective substrates in the invention of claim 15 is one that, as the claim expressly recites, serves to "associate each one of said spaces with a respective corresponding one of said labels according to said sequence". That functional relationship is significant and provides important advantages which, as noted above, are expressly described in the specification. It is respectively submitted that the functional relationship here between the printed matter and substrates recited in claim 15 is at least as significant as those noted by the Federal Circuit in *In re Gulack*, Id. Accordingly, the Examiner misconstrued claim 15 and thus, erred as a matter of law, by failing to consider expressly recited elements of claim 15 in assessing its patentability over the prior art.

When claim 15 is considered as a whole, it is clear that the prior art relied on by the Examiner does not disclose or expressly or impliedly suggest the invention of claim 15 or any of its dependent claims 2 through 11.

The Examiner analogizes the photographer's log (10) of *Jackson '090* to the first substrate (100) labels and series of first indicia (122) of claim 15. *Jackson '090* unquestionably shows removable labels (14A) on a substrate. Those labels (14A) are provided with indicia (14AA) that indicate the correspondence of each label (14A) to the individual frames in a roll of film. However, there is nothing in either *Jackson '090* or *Blank '482* which can properly be construed as meeting or suggesting the recitations of claim 15 directed to a registration log having at least one second substrate, namely:

*"said second substrate having a plurality of label retaining spaces and a series of second indicia, said second indicia corresponding to said first indicia to associate each one of said spaces with a respective corresponding one of said labels according to said sequence."*

As noted above, the Examiner has candidly admitted that a series of second indicia corresponding to the first indicia is missing from the proposed combination on which she bases all of her rejections. The Examiner nonetheless attempts to analogize the registration form (26) of

*Blank '482* to the above-recited second substrate.

That analogy fails. The registration form (26) of *Blank '482* lacks any sequential indicia much less any that sequentially correspond to the frame-indicating indicia (14AA) and the labels (14) from the photo log (10) of *Jackson '090*.

A space (28) is provided for affixing a registration label (18), as shown in Fig. 1b of *Blank '482*, to registration form (26) of Fig. 2. However, there even are no sequential indicia on the registration form (26) which sequentially correspond to the indicia (19) on the label (18) so as to indicate which particular label (18) is to be placed on the registration form (28). Indeed, there is no need for any such sequential correspondence in *Jackson '090*. There is only one label (18) and only one space (28) on the registration form (26), it is clear that the label (18) to be placed in space (28) is the label (18) that has been provided on membership card (10).

This deficiency of *Blank '482* is not cured by *Jackson '090* or any of the other prior art of record. The Examiner does not articulate and Applicant is unable to imagine a logical reason that would motivate a person of ordinary skill to modify the registration form (26) of *Blank '482* to include indicia establishing a sequential correspondence with the indicia (14AA) on the labels (14A) of *Jackson '090*. Doing so would completely frustrate the essential purposes of both of those references. Attaching to the form (26) of *Blank '482* a label (14A) from *Jackson '090* bearing pre-printed indicia corresponding to a given frame in a roll of film instead of the intended label (19) from the card (10) of *Blank '482* would be senseless and serve no conceivable purpose. It would also make that label (14A) unavailable for its expressly taught purpose of being affixed to a photograph as instructed by *Jackson '090*.

Even if the label (14A) of *Jackson '090* were affixed to the registration form (26) of *Blank '482* as the Examiner postulates, the indicia (14AA) on that label would not sequentially correspond to any of the indicia on that registration form (26) (See Fig. 2 of *Blank '482*).



(ii) **The Rejection over *Baldwin '904* in view of *Jackson '090* is Improper.**

- a) **The Examiner Has Again Improperly Failed To  
Give Weight to Expressly Recited Printed Matter**

The Examiner alleges:

*“Baldwin discloses the claimed invention except for the specific arrangement or content of indicia.”*

2/13/04 Office Action at p. 4

The Examiner then again dismisses the patentable significance of the recited “first indicia identifying the position of each of said labels in an uninterrupted sequence...” and the recited “second indicia corresponding to said first indicia...” by repeating the conclusory assertion:

*“It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any additional desired indicia in the label retaining spaces since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. In re Gulack, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of registration log does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.”*

2/13/04 Office Action at p. 4

A verbatim assertion made by the Examiner at pp. 3 & 4 of the 6/30/03 Office Action was quoted above at p. 10. Its error has been pointed out in detail in the argument set forth on pages 10 through 14 above. There is no need to recapitulate that argument here. It suffices to reiterate that the “first indicia...” and “second indicia...” recited in Applicant’s claim 15, in a manner the claim itself expressly recites, are functionally related to their respective substrates. By overlooking that functional relationship, the Examiner erred by failing to give weight to recitations of claim 15 that should have been considered in determining its patentability over the prior art.

b)      The Postulated Combination of *Baldwin '904* and *Jackson '090* Lacks Significant Elements of Claim 15

The Examiner contends:

*“Baldwin discloses the claimed invention except for the specific arrangement and/or content of indicia (the first indicia identifying the position of each of the labels in an uninterrupted sequence and second indicia corresponding to the first indicia to associate each one of the spaces with a respective corresponding one of the labels according to the claim(s).”* (emphasis added)

2/13/04 Office Action at p.4

After dismissing the patentable significance of those indicia with the conclusory passage previously quoted, the Examiner looks to *Jackson '090* to supply the missing first and second indicia stating:

*“Furthermore, Jackson discloses a log book (10) comprising a first substrate (12) locatable at a first location; a plurality of labels (i.e. 14A) detachably adhered to the first substrate, each of the labels having one of a series of indicia (14AA) identifying the position of each of the labels in an uninterrupted sequence. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Baldwin's invention to include indicia identifying the position of each of the labels in an uninterrupted sequence, as taught by Jackson to properly align the labels with the label retaining spaces in chronological order.”*

6/13/04 Office Action pp. 4 & 5

Conspicuously absent from the postulated combination is any element allegedly analogous to Applicant's recited “second indicia corresponding to said first indicia” present on a “second substrate” to “associate each of said label retaining spaces with a respective corresponding one of said labels according to said sequence.” The indicia (14AA) on the labels in *Jackson '090* the Examiner analogizes to Applicant's “first indicia” lack any corresponding counterpart indicia. No corresponding sequential “second indicia” on a second substrate are present in *Jackson '090*. The labels (14A) of *Jackson '090* are adhered to individual photographs, not to anything analogous to a “second substrate” “having a plurality of label retaining spaces” or indeed, to any substrate whatsoever having sequential “second indicia” corresponding to the indicia (14AA) on the labels (14A).

A postulated combination of prior art which lacks significant elements of the invention of claim 15 cannot reasonably be asserted to render that claim unpatentable. That is particularly true

where, as here, the Examiner does not contend the missing elements would somehow otherwise be within the purview of one of ordinary skill in the art.

c) *Baldwin '904 and Jackson '090 Are Non-Analogous  
Art Whose Combination Lacks Prior Art Motivation*

Neither *Baldwin '904* nor *Jackson '090* even recognize the problem of protecting the confidentiality of information entered by a customer when registering at a place of business much less, suggest a solution to that problem along the lines of the claimed invention. *Baldwin '904* deals with the issue of keeping information entered in a personal address book or the like up to date. *Jackson '090* is a log for photographers that enables the photographer to enter information about a photograph on a label in a log and to later remove that label and transfer it to the rear face of the photograph after it has been developed. These references not only fail to combine to produce all the elements of the claimed invention, they are in no way germane to the problem confronting the inventor. The Examiner's underlying assumption that a person of ordinary skill in the art would look to either of these references for a solution to the problem of protecting the confidentiality of customer registration information is untenable.

d) *Additional Arguments Regarding 2/13/04  
Rejections Of Dependent Claims 3 and 4*

As to claim 3, the Examiner argues the recited "designated area for a user of the system to enter a date on which services were provided to the customer is obvious over *Baldwin '904* as modified by *Jackson '090*. In addition to the defects of that combination which have been pointed out above, nothing in that combination suggests an area "designated" for entry of the specific information recited in that claim. A teaching of providing a place (14AC) to enter the date a particular photograph is taken as taught by *Jackson '090* does not suggest providing an area designated for entry of the date services are rendered to a customer. That distinction renders claim 3 patentable on grounds independent and distinct of its dependency from patentable independent claim 15.

As to claim 4, the recited "instructions to attach said labels in said label retaining spaces" is neither shown nor suggested by *Baldwin '904* either above or combined with *Jackson '090*. The assertion that printed matter lacks a functional relationship with a substrate is clearly erroneous

since it expressly facilitates a physical association of the labels and the label retaining spaces. Thus, claim 4 is also patentable over the prior art of record on grounds independent and distinct of those supporting the patentability of claim 15.

In view of the foregoing, Applicant respectfully submits the prior art of record taken as a whole, does not disclose or in any way expressly or impliedly teach or suggest the invention of claim 15 as properly construed.

All of claims 2 through 11, inclusive, depend directly from claim 15. Each of those claims is patentable and the rejections thereof improper for at least the reasons noted above as to claim 15.

## **IX. CONCLUSION**

The Examiner has failed to properly apply controlling case law which compels consideration of printed matter which bears a functional relationship to its substrate in assessing the patentability of the rejected claims. As a result, the Examiner has misconstrued not only claim 15, but each of its dependent claims 2 through 11, as well. By the Examiner's own admission, the postulated combination of *Jackson '090* and *Blank '482* lacks expressly recited elements of the sole independent claim. Moreover, the postulated combination lacks prior art motivation and consists entirely of non-analogous art. As has been pointed out, the postulated combination of *Baldwin '904* and *Jackson '090* also does not support the Examiner's rejections. Those references are not only also non-analogous art, but fail to combine to include all the elements of the invention as claimed. When the claims are properly construed, it is clear they are not rendered obvious by the prior art relied upon by the Examiner.

The art rejections of claims 15 and 2 through 11, inclusive, are improper as a matter of law and should be reversed. Allowance of all pending claims in their present form is solicited.

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Respectfully submitted,

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## APPENDIX

### Claims Involved in the Appeal

2. The customer registration system of claim 15, wherein said registration log includes more than one said second substrate and each said second substrate further includes third indicia to identify a sequential order of said second substrates in said registration log.

3. The customer registration system of claim 15, wherein said second substrate further includes a designated area for a user of the system to enter a date on which services were provided to the customer.

4. The customer registration system of claim 15, further comprising text associated with said label-retaining spaces, said text including instructions to attach said labels in said label-retaining spaces.

5. The customer registration system of claim 15, wherein said plurality of registration labels are detachably adhered to respective ones of a plurality of said first substrates, and wherein said registration log includes a plurality of said second substrates, each of said second substrates including a plurality of label-retaining spaces arranged sequentially thereon for retaining at least some of said labels after entry of information on said labels by customers and detachment thereof from said first substrates.

6. The customer registration system of claim 15, wherein said plurality of said labels are arranged in sets, each of said sets having a given said sequence of

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said first indicia and wherein at least two of said sets have the same said sequence of said first indicia.

7. The customer registration system of claim 15, wherein said first substrate includes a first surface and a mutually opposed second surface and wherein said plurality of labels are adhered only to said first surface.

8. The customer registration system of claim 15, wherein said second substrate includes a first surface and a mutually opposed second surface and wherein said plurality of label-retaining spaces are disposed on both said first surface and said second surface.

9. The customer registration system of claim 15, wherein said first indicia comprises at least one of a numeral and a letter of the alphabet.

10. The customer registration system of claim 15, wherein said second indicia of said label-retaining space comprises at least one of a numeral and a letter of the alphabet.

11. The customer registration system of claim 15, wherein said registration log comprises a spiral bound book.

15. A customer registration system for improving the protection of the confidentiality of information provided by a customer at the time of registration, said system comprising:

at least one first substrate locatable at a first location;

a plurality of registration labels detachably adhered to said first substrate, each of said labels having one of a series of first indicia identifying the position of

each of said labels in an uninterrupted sequence, each of said labels further having at least one field within which the information is to be entered in writing by the customer, said first location being a location sufficiently accessible to the customer to permit the customer to view said labels detachably adhered to said first substrate and to enter the information in said field of one of said labels while said one of said labels remains detachably adhered to said first substrate, and

a registration log having at least one second substrate, said second substrate having a plurality of label-retaining spaces and a series of second indicia, said second indicia corresponding to said first indicia to associate each one of said spaces with a respective corresponding one of said labels according to said sequence, each said one of said spaces including an area to which said respective corresponding one of said labels may be adhered after the information has been entered in writing in said field by the customer and said corresponding one of said labels has been detached from said first substrate so that said labels adhered to said second substrate provide an original record of said writing, said second substrate being locatable at a second location at a time when said first substrate is located at said first location, said second location being a location at which the entered information on any said labels adhered to said second substrate is out of view of the customer in order to protect the confidentiality of the information.